



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,372	11/23/2001	Katsuaki Yamanoi	041465-5128	3256

9629 7590 11/24/2004

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

EXAMINER

PSITOS, ARISTOTELIS M

ART UNIT	PAPER NUMBER
----------	--------------

2653

DATE MAILED: 11/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,372

Applicant(s)

YAMANOI ET AL.

Examiner

Aristotelis M Psitos

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Art Unit: 2653

DETAILED ACTION

Priority

Applicants' response of 9/13/04 has been considered with the following results.

Specification

The amendment to the title of the invention has been entered. The examiner appreciates applicants' cooperation.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 23 and 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The examiner cannot ascertain where/what permits the appropriate register to function as claimed, i.e., "after changing a part of the group information". Further identification/clarification is respectfully required.

Dependent claim 24 does not clarify and falls with its parent claim.

2. Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure, which is not enabling. The argued ability, i.e., "a recording apparatus which performs grouping processing originally and automatically during recording of the data" is neither found in the claims, nor readily apparent from the disclosure. This ability is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

As far as the claims recite positive limitations, the following art rejections are made.

Art Unit: 2653

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly

Art Unit: 2653

owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1,21-22 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morohashi further considered with Heo.

Claim 1	Morohashi
An information recording apparatus	title/abstract
an information attaching and generating device, which	applicant's attention is drawn to the
attaches track number information to each track recorded	ability in the system so as to
in an information recording medium and generates group	have "group management data".
control information to control one or a plurality of	The purpose of such is as claimed.
tracks as one group;	
a detection device for giving a grouping instruction	The control elements in Morohashi
to said information attaching and generating device when	permit the system to respond to
a change in track recording is detected.	the playback system of Morohashi
	in accordance with the detected
	condition.

wherein ...

Furthermore, with respect to the independent claim the system – see abstract permits a user to influence the ability of associating a plurality of files in "groups". This is done by having the recited "group management data". This meets the independent claim.

With respect to dependent claim 21 and 22, these claims call for a register, which registers which tracks belong to the same group. Applicant's attention is drawn to figures 6a-c and the associated disclosure with respect to managing pieces of music data – inherently there is a register in the overall

Art Unit: 2653

system – CPU (microprocessor/controller) that permits the association of that/those information tracks belong to what group. This is commonly preformed by the pointer ability in this environment.

The examiner concludes that under 102 considerations, such register(s)/apparatus is inherently present in the Morohashi document, and inherently track association – which tracks belong to which group is present.

If applicants' could convince the examiner that such is not present then the examiner would rely upon Heo et al for teaching start and ending (pointing) address ability with respect to his audio stream attribute table information –

It would have been obvious to modify the base system of Morohashi with the above teaching from Heo et al; motivation is to permit multi-tracks to be associated with particular groups.

Response to Arguments

Applicant's arguments filed 9/13/04 have been fully considered but they are not persuasive. The examiner cannot reconcile the claims rejected as analyzed above with applicants' arguments. With respect to the wherein clause, the grouping data inherently permits the generation of the group control information from the start of recording till the point when the grouping instruction is received, otherwise there would be no response/recognition of the grouping data. By definition, Morohashi must provide for grouping data during recording. The argued, "in the manner recited in claim 1" fails to overcome the above rejection.

4. Claims 1-22 rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/34601 to Otomo et al further considered with Yokota et al.

Claim 1

An information recording apparatus

an information attaching and generating device, which
attaches track number information to each track recorded

Otomo et al

title/abstract

applicants attention is drawn to the
ability in the system so as to

Art Unit: 2653

in an information recording medium and generates group control information to control one or a plurality of tracks as one group; a detection device for giving a grouping instruction to said information attaching and generating device when a change in track recording is detected.

have AOTT_GR, with respect to figure 23. As further identified with the ability to "group" albums, etc. The control elements in Otomo et al permits the system to respond to the playback system of Otomo et al is in accordance with the detected condition.

wherein ...

Furthermore, these references are relied upon for the reasons stated in the submitted search report. As far as the examiner can ascertain, all the above limitations are indeed present.

The base reference to Otomo et al as indicated on page 35 to page 36 disclose the claimed devices that permits the recording/giving of a group instruction/management data when "any kind of change regarding track recording is detected". Applicant's attention is also drawn to the corresponding US patent that can also be relied upon in place of the WO document to Otomo et al (US 6748160).

With respect to the particular types further elaborated upon by the dependent claims, these are taught by the secondary reference to Yokata et al at the indicated passages.

It would have been obvious to modify the base system of Otomo et al with the above additional teachings from Yokota et al, motivation is to permit the system to give group instruction(s) during/for particular events as indicated.

Again, the register(s) limitations of claims 21 & 22 are considered inherently present .

Response to Arguments

Applicant's arguments filed 9/13/04 have been fully considered but they are not persuasive. The examiner cannot reconcile the claims rejected as analyzed above with applicants' arguments. With respect to the wherein clause, the grouping of the data inherently permits the generation of the group control information from the start of recording till the point when the grouping instruction is received, otherwise there would be no response/recognition of the grouping data. By definition, Otomo et al must

Art Unit: 2653

provide for grouping data during recording. The argued, position as stated on page 14 of applicants' remarks with respect to Otomo does not teach ... " a recording apparatus which performs grouping processing originally and automatically during recording of data, in the manner recited in claim 1" is not convincing. Not only is there no originally and automatically grouping recited in the claim, but as analyzed above, the claimed limitations are met.

5. Claims 1-3 are rejected under 35 USC 102 (e) as anticipated by Hamai et al.

Claim 1

Hamai et al

An information recording apparatus

title/abstract

an information attaching and generating device, which
attaches track number information to each track recorded
in an information recording medium and generates group
control information to control one or a plurality of
tracks as one group;
a detection device for giving a grouping instruction
to said information attaching and generating device when
a change in track recording is detected.

applicants attention is drawn
ability in the system so as to
have track group information,
figure 24. As further identified
with this ability a number of
data tracks are formed with respect to
each data track group.
The playback system of Hamai et al
is in accordance with the detected
condition/ see for instance col 36,
lines 44 till col. 38 line 51.

wherein ...

The examiner interprets the track numbering to be inherently present since this is a tape
System, and identification of which track is where is commonly provided in order to retrieve the
information recoded accordingly.

With respect to the limitations of claim 2, end of track identification is disclosed with respect to
end of mark for instance.

Art Unit: 2653

With respect to claim 3, since this is a tape, and such is a sequential system, the tack numbering inherently met this limitation.

Response to Arguments

Applicant's arguments with respect to the above claims have been considered but are moot in view of the new ground(s) of rejection.

6. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1-3 as stated in paragraph 5 above, and further in view of Yokota et al.

Hamai et al do not specify pause ability.

Yokota et al teaches in this environment the ability to pause the system and provide management information indicative thereof.

It would have been obvious to modify the base system of Heo et al with the above pause ability indication so as to permit a user to discriminate between "paused" conditions and hence increase the flexibility of Heo et al by letting the system provide appropriate indication thereof. The use of "pause" ability especially in DVD systems is considered motivation, i.e., permitting systems to keep track and indicate pauses.

7. Claims 8-16, 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 as stated in paragraph 5 above, and further in view of Heo et al.

Heo et al is a DVD audio disc recording system, which permits the user to associate information into groups as the user designs/selects. – see the abstract. See the discussion with respect to audio packets having the appropriate quantization, sampling, title management table, etc..

The claims are further analyzed below:

With respect to claim 8, the examiner interprets this as the different format ability in Heo et al.

With respect to claim 9, this is inherent otherwise any change in-group information would be lost.

With respect to claim 10, again numbering continuously increases.

With respect to claim 11, operating state is interpreted as a different sampling/quantization level.

Art Unit: 2653

With respect to claim 12, subsequent group indication/data is not the same as that previously recorded.

With respect to claim 13, again, track numbering continuously increases.

With respect to claim 14, recording mode – see discussion with respect to MPEG2, or alternatively, stereo and mono modes.

With respect to claim 15, yes otherwise distinction between groups would not be detectable.

With respect to claim 16, continuously increasing of track numbering.

With respect to claims 21-22, registers are considered inherently present in the Heo et al system, which are used to discriminate the associated table information.

It would have been obvious to modify the base system of Hamai et al with the additional teaches as identified above with respect to Heo et al, motivation is to include the additional aux information for identification purposes as well as expanding the robustness of the overall system so as to provide for the additional features.

8. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 1 as stated in paragraph 5 above, and further in view of Hartung et al.

Hartung et al disclose a multipurpose digital recording system wherein a plethora of encoding techniques for identification purposes so as to expand the flexibility of the information recorded (and hence reproduced) are presented.

With respect to claim 17, applicants' attention is drawn to table 16, which indicates that identification of the information source is provided.

With respect to claim 18 the ability of interleaving different tracks subsequently (after group instruction) from the track already recorded is readily depicted by table 6 which teaches that the group attribute has discontinuities enabling previous information in a compressed format, while the next information (dat entry) is not. The examiner interprets such as meeting this claimed limitation.

Alternatively, applicants' attention is drawn to table 13, which depicts the identification of various types of information per field/group, which also teaches the ability of having different tracks follow each other.

Art Unit: 2653

With respect to claim 19, since Hartung et al is a tape device, inherently the tracks continuously increase as one progress along the length of the medium – hence the sequential recording format well recognized for tapes.

With respect to claim 20, the ability of discriminating the track number information prior to a grouping instruction and subsequent thereto is inherently provided in Hartung et al, else there would be no recognition of what track is where.

It would have been obvious to modify the base system of Hamai et al with the above additional teachings from Hartung et al, motivation is to permit a user identifying various signal sources – see table 24 in Hartung et al for inventory purposes. The remaining teachings with respect to claims 18-20 follow so as to provide the appropriate identification/expansion of the recording parameters found in Hamai et al.

This will permit a user to have greater flexibility and user friendliness for the overall tape system.

9. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1-3 as stated in paragraph 5 above, and further in view of well known word processing nomenclature and the Dewey-Decimal system.

With respect to claim 23, the examiner interprets such to mean an indication of various versions of a recording. This ability to indicate versions is well known in the word processing arts, i.e., version 1, version 2, etc. Hence, the examiner concludes that one of ordinary skill in the art to use such well-known nomenclature to permit various version identification, motivation is to permit historical recording of tracks to be noted.

With respect to claim 24, the ability of having a numbering scheme using "sub-number" is considered well established – as taught by the Dewey-decimal system.

It would have been obvious to modify the base system to Hamai et al in order to permit a finer division of the tracks.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 2653

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2653



AMP